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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,111	05/22/2001	Soo-Ick Lee	678-613 (P9627)	9177

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,111

Applicant(s)

LEE, SOO-ICK

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claim(s) 2, 6, 7-8, 10-12 and 14-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mölne (US 5,943,611) in view of Asaoka et al. (US 6,349,203 B1).

Regarding **claim(s) 7, 10, 12 and 15**, Mölne discloses a system for inputting an address book into a mobile communication terminal (column 1, lines 12-14), the system comprising:

a mobile communication terminal in communication with a mobile switching center for requesting address book information by transmitting an address book service number, and storing the address book information when it is received (FIG. 1 and column 5, lines 9-59) [The cellular radiotelephone 16a in communication with a mobile switching center 14a to obtain a desired telephone number by transmitting an input search criteria to identify a telephone number which returned and stored in the cellular telephone 16a memory];

a home location register in communication with the mobile switching center (FIG. 3 and column 10, lines 17-32) [The home local registration 25c in communication with mobile switching communication 14c]; and

an address book management center in communication with the mobile switching center for retrieving and transmitting the address book information corresponding to the characteristic number (FIG. 1 and column 6, lines 43-55) [The network directory database 22a in communication with the mobile switching system 14a for retrieving and transmitting the information corresponding to the information inputted by the cellular radio telephone 16a].

Mölné discloses the cellular radio telephone submitted a name to the network directory database but fails to disclose the address book service number including a characteristic number allocated to a client.

However, Asaoka teaches the address book service number including a characteristic number allocated to a client (column 6, lines 18-26) [The informed of the

version number of the currently available services. The informed version number is allocated to the device requesting the information].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Mölne using the device as taught by Asaoka.

This modification of the invention enables the system to transmit the informed version number so that the user would have an accurate update of the address book memory.

Regarding **claim(s) 2**, Mölne discloses the address book management center transmits the address book information corresponding to the characteristic number in short message form to the mobile communication terminal (column 6, lines 43-55).

Regarding **claim(s) 6**, Mölne discloses the address book management center searches for the address book information corresponding to the characteristic number to transmit the retrieved information to the mobile communication terminal in combination with an advertisement (column 6, lines 43-55).

Regarding **claim(s) 8**, Asaoka teaches if a password is set in the address book information requested from the mobile communication terminal, further comprises the step of confirming in the address book management center if the password is transmitted from the mobile communication terminal (column 5, line to column 6, line 6).

Regarding **claim(s) 11**, Mölne discloses the address book information is updated and stored, if the address book information is previously stored (column 5, lines 47-59).

Regarding **claim(s) 14**, Mölne discloses transmitting changed information in the address book information to the mobile communication terminal, if there is changed information in the address book information (column 5, lines 47-59).

Regarding **claim(s) 16**, Mölne discloses the address book management center is comprised of a control unit and a database (column 8, lines 36-47).

Regarding **claim(s) 17**, Mölne discloses the address book management center receives a request for information from the mobile switching center (column 8, line 62 to column 9, line 17).

Regarding **claim(s) 18**, Mölne and Asaoka disclose all the limitations of **claim(s) 18** as stated in **claim(s) 15'** s rejection above and furthermore Mölne discloses requesting an address book information by dialing a number (column 1, lines 36-47) [The cellular user dials the directory assistance number to request information].

4. **Claim(s) 3-5 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mölne in view of Asaoka and in further view of Miller et al. (US 6,421,707 B1).

Regarding **claim(s) 3 and 9**, Mölne and Asaoka as applied to **claim(s) 7 and 18** above differ from **claim(s) 3 and 9**, in that it fails to disclose transmitting an advertisement together with the retrieved information that is transmitted to the mobile terminal.

However, Miller teaches confirming if the received short message is a special short message about the address book information (column 4, lines 40-60); and automatically storing the special short message about the address book information (column 3, lines 39-51).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Mölne using SMS notification system as taught by Miller.

This modification of the Lindquist invention enables the system to transmit the change in the address book so that the user would have update address book information in the mobile phone.

Regarding **claim(s) 4**, Miller teaches the step of storing in the mobile communication terminal the received address book information further comprises updating the stored address book information, if the short message about the address

book information is a short message about previously stored address book information (column 3, lines 39-51).

Regarding **claim(s) 5**, Miller teaches transmitting from the address book management center the changed address book information to the mobile communication terminal, if there is changed information in the address book information (column 4, lines 40-60).

5. **Claim(s) 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mölne in view of Asaoka and in further view of Gledje (US 2002/0032771).

Regarding **claim(s) 13**, Mölne and Asaoka as applied to **claim(s) 12** above differ from **claim(s) 13**, in that it fails to disclose transmitting an advertisement together with the retrieved information that is transmitted to the mobile terminal.

However, Gledje teaches transmitting an advertisement together with the retrieved information that is transmitted to the mobile communication terminal (¶ 022).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Mölne using the advertisement server as taught by Gledje.

This modification of the Lindquist invention enables the system to transmit advertisement using the SMS message notification so that the user would receive event-based advertisements.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
March 14, 2005



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